

Applicant respectfully thanks the Examiner for the Examiner's careful consideration and further scrutiny of Morrison et al. in the subject Official Action. Nonetheless, applicant respectfully traverses the rejections on the grounds that Morrison et al. teach away from the use of header data across picture boundaries. Each of the rejected claims recite the use of a first picture header to encode a second (or succeeding) picture.

Morrison et al. describe a preferred decoder at column 7, line 63 to column 9, line 31. This decoder scans an incoming data stream for a picture start code indicating the start of a new picture. Column 7, lines 63-65. Upon receiving a picture start code, the decoder *resets* to a base memory address. Column 8, lines 10-14. From the base memory address, the decoder operates to translate the incoming data stream into a picture signal. Specifically, the decoder passes the incoming data through buffer 47, which acts as a rate convertor, to a demultiplexor 49. Column 8, lines 39-49; column 8, lines 56-58. The demultiplexor 49 writes header data to an overhead fifo 490, and coefficient data to a coefficient fifo 491. The demultiplexor 49 uses these to produce a picture signal.

Applicant respectfully notes two aspects of the above described decoder that teach away from using header data from a first picture to code a second (or succeeding) picture. First, the decoder of Morrison et al. is reset to a base address of memory upon receipt of a picture start code. Column 8, lines 10-14. This suggests that any state information associated with a previous picture is lost upon the start of a new picture and that each picture is treated as a separate unit. In other words, the

decoder produces each new picture based upon new header data. Accordingly, Morrison et al. teach away from the use of a first header to encode a second (or succeeding) picture.

Second, the decoder of Morrison et al. stops reading data from the buffer 47 for the current picture upon detection of a new picture start code. Column 8, lines 62-66. This likewise suggests that each picture is treated as a separate unit and teaches away from the use of a first header to encode a second (or succeeding) picture.

Moreover, as detailed in applicant's response mailed October 29, 1998, which is incorporated herein by reference, Morrison et al. teach that a picture header will be supplied at the start of each picture. Column 5, lines 2-4. Applicant respectfully submits that this likewise suggests that each picture is treated as a separate unit. Accordingly, this further teaches away from using a first picture header to encode a second (or succeeding) picture.

The Examiner cites column 5, lines 13-20 for teaching the selective generation of header data. Applicant respectfully notes that this paragraph is directed toward determining whether to generate a *block* header within a single picture. Column 5, line 13. As detailed by Morrison et al., a block header is omitted if it would duplicate control information contained in a group header or a picture header. Column 4, lines 42-48. Applicant respectfully submits that the selective generation of block headers within a single picture does not teach or suggest the use of picture headers across picture boundaries.

The Examiner further cited column 9, lines 20-32 for teaching the "use one header to represent

appropriate information from multiple pictures in a sequence for the purpose of reconstruction." Paper 25, page 3. The cited portion of Morrison et al. discusses a "picture repeat control unit 46." Column 9, line 22. The picture repeat control unit 46 merely repeats an old picture if a new picture is not timely received. Applicant respectfully submits that this portion of the cited reference similarly suggests decoding each picture as a separate unit. Accordingly, applicant respectfully submits that this teaches away from the use of a first header to encode a second (or succeeding) picture.

Applicant respectfully reminds the Examiner that obviousness must be determined without the benefit of applicant's disclosure. Applicant respectfully submits that the use of picture headers across picture boundaries only becomes obvious, if at all, when considered from hindsight in light of applicant's disclosure.

The Federal Circuit has stressed that the "decision maker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566, 1 USPQ2d 1593 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which is strongly discouraged by the Federal Circuit. Panduit, 810 F.2d at 1568; In re Fine, 837 F.2d at 1075; In re Dow Chemical, 837 F.2d 469 (Fed. Cir. 1988). In W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), the Court states:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no

prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher. Gore, 721 F.2d at 1553.

As the Examiner properly identified, Morrison et al. disclose *picture header sequences*. However, Morrison et al. consistently teach that an individual picture header is used to encode a single picture. Applicant respectfully submits that the use of a first picture header to encode a second (or succeeding) picture only becomes obvious, if at all, when considered with the benefit of applicant's disclosure.

Each of independent claims 1, 3, 6, 8, 10 and 13 recite the use of header data from a first picture to code a second (or succeeding) picture. Each of dependent claims 2, 7, 9, and 13 recite further elements or steps. Accordingly, applicant respectfully submits that the application stands in condition for allowance. The Examiner's reconsideration and further examination are respectfully requested.

Respectfully submitted,
LIMBACH & LIMBACH L.L.P.

Dated: 6/1/98

By: 

Heath W. Hoglund
Reg. No. 41,076

Attorneys for Applicant(s)

Atty Docket No. SONY-C4021